

REMARKS

The Examiner has maintained his rejection of all of the claims under 35 U.S.C. §103 as obvious over Rinck et al., U.S. 3,382,580 ("Rinck"), in view of Messinger et al., U.S. 5,185,933 ("Messinger"). The reasoning of the rejection is understood to be as follows: (1) Rinck shows shaving foils with apertures; (2) Messinger shows a foil with two different aperture shapes (his Fig. 8); (3) while the prior art does not show a Penrose parquet foil aperture pattern,

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If one wanted to use this design for a shaving foil it would have been an obvious matter of choice of a variant pattern, wherein any variant pattern would inherently provide cutting as much as applicant's design. For example, paisley patterns, Ammann-Beenker patterns, Escher patterns, etc. would be capable of cutting as well and perhaps to at least the same degree.¹

Applicants have firmly traversed this rejection as not only a clearly improper application of §103 and contrary to established case law regarding obviousness determinations, but also based upon an unsupported and incorrect presumption, by the Examiner, as to the shaving performance of various hypothetical foil patterns. The Examiner has provided no rebuttal to Applicants' contention that the Examiner's predictions about whether a particular pattern is more effective than another is immaterial to the proper standard of determining non-obviousness, not to mention unsupported by any basis in fact. That Rinck considered his foil, at the time of his invention, to be "more efficient than other shaving foils due to a 'high opening ratio'" is equally immaterial. The standard for non-obviousness is NOT whether a claimed combination is more efficient, or in any other way better than, the known prior art. Rather, the standard is whether one of ordinary skill, at the time of the invention, would have been sufficiently motivated to modify the prior art to create the invention. And the Examiner has provided no response to Applicants' request that he point to even a single prior art reference to explain how one of ordinary skill would be motivated to incur the extra complication of a quasi-periodic pattern, such as a Penrose parquet.

¹ Final Office Action, page 2, last two sentences.

The Examiner has apparently dismissed without comment Applicants' teaching and explanation, both in the specification and in their first response, as to why the specific patterns claimed are particularly advantageous in shaving foils, why their selection results from a new realization of the efficacy of certain pattern characteristics to the effective engagement and cutting of hair, and therefore why their presence in the claims is not simply a matter of design choice or rote optimization.

The Examiner has revised his position in one respect, now stating that "the pattern in Messinger is considered quasi-periodic due to the unsymmetrical pattern."² However, Messinger simply discloses shaving foils consisting of two regions in each of which all openings have a common shape and are arranged in simple columns and rows. Thus, Messinger does not supply the missing feature of five-fold symmetry, nor anything that in any interpretation could be considered a Penrose parquet.

The Examiner has also failed to respond to Applicants' showing that the Rinck reference itself teaches away from patterns with "differently oriented hair entry openings," due at least to resulting variations in foil strength because of what he considers the "unfavorable arrangement of the bars between the openings."³ Instead, Rinck touts a regular pattern of diamond-shaped apertures that he says avoids such disadvantages. Thus, not only does the base reference teach away from the invention, it disputes the Examiner's presumption regarding equality of patterns. Such teaching away from the Examiner's suggested modification must be considered,⁴ and "a *prima facie* case of obviousness can be rebutted if the Applicant ... can show 'that the art in any material respect taught away' from the claimed invention."⁵

The Examiner has also failed to provide any reasonable support, as requested by Applicants, for his finding all of the dependent claims to be matters of 'obvious design choice.'

² Final Office Action, page 3, last line of first paragraph.

³ Rinck, col. 1, lines 42-54.

⁴ *In re Gurley*, 27 F.3d 551, 31 USPQ2d 1130 (Fed. Cir. 1994) "A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following ... the path that was taken by the Applicant."

⁵ *In re Geisler*, 116 F.3d 1465, 1469, 43 USPQ2d 1362, 1365 (Fed. Cir. 1997), quoting *In re Malagarai*, 499 F.2d 1297, 1303, 182 USPQ 549, 553 (CCPA 1974). Accord, *In re Haruna*, 249 F.3d 1327, 58 USPQ2d 1517 (Fed. Cir. 2001).

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For at least all of these reasons, Applicants respectfully submit that no prima facie case of obviousness has been presented against claims 1 and 13 and the claims depending from them, and urges the Examiner to withdraw this rejection and allow the claims.

Applicants are filing herewith their Notice of Appeal, simply to preserve their rights should the Examiner persist in the present rejection.

No fees are believed due. Please apply any charges or credits to deposit account 06-1050, referencing the above attorney docket number.

Respectfully submitted,

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